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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/014,076	01/27/1998	MAX A. FEDOR	D-1056 DIV3	4092

28995 7590 05/09/2008

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EXAMINER	
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ART UNIT	PAPER NUMBER
3653	

MAIL DATE	DELIVERY MODE
05/09/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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TECHNOLOGY CENTER 3600

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In re Application of
Fedor, et al.
Application No. 09/014,076
Filed: January 27, 1998
For: METHOD FOR TRACKING AND DISPENSING MEDICAL ITEMS

: DECISION ON PETITION
: REGARDING REQUEST TO
: WITHDRAW REQUIREMENT
: FOR INFORMATION OR
: WITHDRAW A HOLDING
: OF NON-RESPONSIVE
REPLY

This is a decision on the petition under 37 CFR 1.181 filed May 19, 2006, requesting withdrawal of a Requirement for Information pursuant to 37 CFR § 1.105 mailed December 19, 2005 or, alternatively, To Have the Holding Of Non-Responsive the Petitioner's Reply to the Requirement Withdrawn.

The petition to Withdraw the Requirement for Information is **DENIED**.
The petition to Withdraw the Holding of the Reply to the Requirement of Information as Non-Responsive is **GRANTED**.

This application was filed on January 27, 1998. A non-final office action was mailed on June 7, 2000 rejecting claims under 35 U.S.C. § 103 as unpatentable over Pearson '232 in view Meador. On August 30, 2000, in response to the rejection, Petitioner filed a Declaration of R. Michael McGrady under 37 CFR § 1.131 to swear back of the Pearson '232 and Meador references by establishing that the invention claimed in the instant application, or an obvious variation thereof, was completed by being conceived and reduced to practice in this country prior to March 7, 1994. In a final office action mailed November 16, 2000, the examiner indicated that the declaration was sufficient. On July 17, 2003, the Board of Patent Appeals and Interferences docketed an appeal in this application for decision. The Board of Patent Appeals and Interferences Remanded this application to the Examiner on July 23, 2004 with instructions to reconsider the sufficiency of the Declaration of R. Michael McGrady under 37 CFR § 1.131. On September 15, 2004, in response to the Remand, the Examiner clarified the record and provided reasons why the Declaration of R. Michael McGrady under 37 CFR § 1.131 to was deemed sufficient. On October 22, 2004, the Board of Patent Appeals and Interferences docketed this application for decision. On October 29, 2004, Petitioner filed a Reply Brief and the Board of Patent Appeals and Interferences Remanded this

application to the Examiner for consideration of the Reply Brief. On April 19, 2005, the Board of Patent Appeals and Interferences docketed the appeal in this application for decision for a third time. On December 15, 2005, the Board of Patent Appeals and Interferences, once again, Remanded this application to the Examiner with instructions to reconsider the sufficiency of the Declaration of R. Michael McGrady under 37 CFR § 1.131. On December 19, 2005, the Examiner mailed a Requirement for Information pursuant to 37 C.F.R. § 1.105 requesting additional evidence from the Petitioner to clarify the matter. On January 17, 2006, the Petitioner replied with remarks stating that the Declaration is sufficient. On May 3, 2006, the Examiner mailed an Advisory Action indicating that the Petitioner's reply was non-responsive to the Requirement for Information pursuant to 37 C.F.R. § 1.105. On May 19, 2006, Petitioner filed a Petition under 37 CFR 1.181 filed May 19, 2006, requesting the withdrawal of the Requirement for Information pursuant to 37 CFR § 1.105 mailed December 19, 2005 or To Have the Holding of Non-Responsive Withdrawn.

The Petitioner alleges the Requirement is legally improper because prosecution of the application is closed. Additionally, the Petitioner alleges that there is no evidence of Office policy for making the Requirement.

M.P.E.P. § 704.11(b) states, "A requirement for information under 37 CFR 1.105 is discretionary. A requirement may be made at any time once the necessity for it is recognized and should be made at the earliest opportunity after the necessity is recognized. The optimum time for making a requirement is prior to or with a first action on the merits because the examiner has the maximum opportunity to consider and apply the response. Ordinarily, a request for information should not be made with or after a final rejection."

In this application, the Requirement was made after a Remand from the Board of Patent Appeals and Interferences. Although the M.P.E.P. states that the best time to make a requirement is prior to or with a first action on the merits, and it states that ordinarily, a request should not be made with or after a final rejection, there is no prohibition on making a requirement for information at any time once the necessity for it is recognized. Therefore, the Requirement is not legally improper because prosecution of the application is closed.

The Petitioner also alleges that the Requirement is legally improper because the information requested is not reasonably necessary to properly examine or treat a matter in the application.

M.P.E.P. § 704.11 states, "The criteria stated in 37 CFR 1.105 for making a requirement for information is that the information be reasonably necessary to the examination or treatment of a matter in an application. The information required would typically be that necessary for finding prior art or for resolving an issue arising from the results of the search for art or from analysis of the application file. A requirement for information necessary for finding prior art is not a substitute for the examiner performing a search of the relevant prior art; the examiner must make a search of the art according to MPEP §

704.01 and §§ 904 – 904.03. The criteria of reasonable necessity is generally met, e.g., where:
(A) the examiner's search and preliminary analysis demonstrates that the claimed subject matter cannot be adequately searched by class or keyword among patents and typical sources of non-patent literature, or
(B) either the application file or the lack of relevant prior art found in the examiner's search justifies asking the applicant if he or she has information that would be relevant to the patentability determination."

In this application, the Examiner has requested the information to resolve an issue arising from the results of an analysis of the application file by the Board of Patent Appeals and Interferences. Therefore, the Requirement is legally proper and necessary to treat a matter in the application.

The Petitioner states that if the Petition regarding the legality of the Requirement is denied, the Petitioner requests withdrawal of the holding of the Reply to the Requirement filed January 17, 2006 as non-responsive to the Requirement.

M.P.E.P. § 704.12(b) states, "A reply stating that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was requested will generally be sufficient unless, for example, it is clear the applicant did not understand the requirement, or the reply was ambiguous and a more specific answer is possible.

In the response to the Requirement filed January 17, 2006, on page 4, lines 1-2, Petitioner states, "The information requested to be submitted is unknown and/or is not readily available to the party or parties from which it was requested." Therefore, the Petitioner's response to the Requirement was complete and responsive.

The holding of the Reply filed January 17, 2006 as Non-Responsive to the Requirement for Information is hereby vacated. The application will be forwarded to the Examiner for consideration of the above reply on its merits. If the Reply does not clarify the record regarding the sufficiency of the Declaration, the Examiner should reinstate any appropriate rejections and provide the applicant the opportunity to properly appeal the application to the Board of Patent Appeals and Interferences.

Any questions regarding this decision should be directed to Patrick Mackey at (571) 272-6916.

Kathy Matecki

Kathy Matecki, Director
Technology Center 3600
(571) 272-5250

Pm/snm: 4/28/08

SM